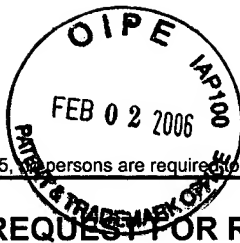


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ORCL5638

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on January 26, 2006Signature Typed or printed name Nita J. Miller

Application Number

09/607,914

Filed

June 29, 2000

First Named Inventor

Chingwei CHENG

Art Unit

3623

Examiner

Catherine M. COLON

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.


This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 37,970
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


SignatureAlan W. YOUNG

Typed or printed name

650-851-7210

Telephone number

January 26, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of)	Examiner: Eric T. SHAFFER
Chingwei Peter CHENG and Sang LEE)	Group Art Unit: 3623
For: METHODS AND SYSTEMS FOR)	Confirmation No.: 2945
DEFINITION AND CATEGORIZA-)	Customer No.: 53156
TION CUSTOMER LIFECYCLE)	
Serial No.: 09/607,914)	
Filed: June 29, 2000)	
Atty. Docket No.: ORCL5638)	<u>PRE-APPEAL BRIEF REQUEST FOR</u>
)	<u>REVIEW</u>

CERTIFICATE OF MAILING UNDER 37 CFR §1.8

I hereby certify that this document is being deposited in the United States Postal Service as first class mail in an envelope with sufficient postage addressed to: MAIL STOP AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on **January 26, 2006**.


Nita J. Miller

MAIL STOP AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request that the present application be reviewed under the provisions of the Pre-Appeal Brief Conference Pilot Program, as published in the Official Gazette of the United States Patent and Trademark Office of July 12, 2005, at Volume 1296 Number 2 and which was extended "until further notice" by Commissioner John Doll on January 10, 2006.

Applicants request Pre-Appeal Brief Review based on clear errors in Examiner's rejections and Examiner's omission of one or more essential elements needed for a *Prima Facie* rejection.

I. Clear Factual Error: Deaton et al. teach two historical periods in Table 5

The Examiner, in the outstanding Final Office Action (hereafter, FOA) of August 26, 2006 states, on page 2, that Deaton et al. teach two selected historical periods (10/1/91 to 12/01/91). However, that is a single date range (in this case, two months), and not two historical

periods. Indeed, Table 5 is labeled “Date Range: from 10/1/91 to 12/1/91” 10/1/91 is not a period, it is a date. Likewise, 12/1/91 is not a period, it is also a date. 10/1/91 to 12/1/91 does not constitute two historical periods but a single period that is two months long. The Office has made a clear factual error, therefore, by analogizing the claimed two selected historical periods with a single two month long period of time.

II. Clear Legal Error: Examiner’s omission of one or more essential elements needed for a *Prima Facie* §103(a) rejection

According to the claimed embodiment, the lifecycle factor may be computed by multiplying the determined absolute value with a percentage measure growth of the selected measure over two selected historical periods. Therefore, the claims expressly call for a) the determined absolute value, b) the percentage measure growth and c) the product of a) and b) – all over two selected historical periods within the selected calculation period.

A. Examiner has not shown how Deaton would be modified to meet claim limitations

At the outset, §706.02(j) Contents of a 35 U.S.C. 103 Rejection, lists four requirements for a §103 rejection, the third of which states that the Office should state “(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter”. The Office has not pointed to any modifications of Deaton et al. that would yield the claimed invention. The Office points to Tables 5 and 6 of Deaton et al. for a teaching of frequency and dollar volume for each customer visit, which the Office intimates could be used to calculate the claimed lifecycle factor (FOA, page 5). It is respectfully submitted that this is not the case. Table 5 lists the Shopping Frequency per Customer, the Total Customers, the % Customers Shopping per Period, the % Total Customer Base, the Total \$ Spent for Period, the % Total \$ Spent per Period, the Average Check per Visit and the Average \$ Spent per Customer. Table 6 lists the Total Customers the % Total Customer Base, the Total \$ Spent for Period, the Average Check per Visit, the Average \$ Spent per Customer, the Total Visits per Customer and the Average Visits per Customer.

Nowhere does Deaton et al. teach or suggest an absolute value of a difference of the selected measure determined over two selected historical periods within the selected calculation period, as required by the claims. In fact, no absolute value of any difference is taught or suggested in Deaton et al. – the phrase “absolute value” does not even appear in the patent. Moreover, nowhere do Deaton et al. teach or suggest a percentage measure growth of the

selected measure determined over two selected historical periods within the selected calculation period, as also required by the claims – in fact this is acknowledged in the FOA at page 3. In fact, the term “growth” is wholly absent from this patent – and the growth of a customer over two selected historical periods expressed as a percentage is also wholly untaught and unsuggested by this reference. Even in the face of such acknowledged deficiencies in the single applied reference, the Office has not presented any proposed modifications to Deaton et al. that would yield such values, as required by the Office’s own guidelines and as memorialized in the MPEP.

B. Office erred in its §103 rejection based upon “rearrangement of parts” argument

The Office appears to suggest that some undefined re-arrangement of the elements of Tables 5 and 6 of Deaton et al. would yield a) the determined absolute value over two selected historical periods, b) the percentage measure growth over two selected historical periods and c) the product of a) and b) to thereby achieve the recited lifecycle factor. See FOA, pages 3 and 5. In this regard, the Examiner’s attention is drawn to the Office’s own guidelines for formulating a §103 rejection based upon such a rearrangement of parts, at §2144.03:

Rearrangement of Parts

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Here the Office appears to contend that a worker of skill in this art could re-arrange the parts of Tables 5 and 6 (and the frequency and dollar volume measurements) to meet the terms of the independent claims. However, the Office has not advanced any way to effectuate such rearrangement or any motivation or reason for the worker to do so, without benefit of the applicant’s claimed embodiment. Here, Deaton et al. has provided no motivation to make the necessary changes to the reference method to meet the terms of the claims. Deaton et al. teach no absolute values of any difference of selected measures and do not teach any growth or percentage growth – and much less over two selected historical periods – as acknowledged by

the Office. Hence, there appears to be no support in Deaton et al. for the Examiner's contention that the applied reference renders the claimed embodiments obvious.

C. Clear Legal Error: Reliance upon art that is not applied

The FAO acknowledges that Deaton et al. do not disclose the claimed lifecycle factor (page 5), is mistaken regarding the two selected historical periods (page 2), acknowledges that Deaton et al. do not teach calculating a percentage measure growth (pages 3 and 5), mistakenly relies upon a "re-arrangement of parts" argument (see above), and relies upon a reference that was not even applied (Engler et al.) for a supposed teaching of a percentage measure growth over two selected historical periods. It is respectfully submitted that the Examiner may not rely upon art that is not applied in his §103(a) rejection, on the basis of a groundless argument that a percentage measure growth over two selected historical periods is well known.

D. Clear Legal Error: Motivation not present in Deaton et al.

Section 706.02(j) of the MPEP, Contents of a 35 U.S.C. §103 Rejection, provides some guidance as to the Office's initial burden in formulating a §103(a) rejection:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Again, the FAO acknowledges that Deaton et al. do not disclose the claimed lifecycle factor (page 5), is mistaken regarding the two selected historical periods (page 2) and acknowledges that Deaton et al. do not teach calculating a percentage measure growth (pages 3 and 5). The Deaton et al. reference, therefore, cannot be said to "expressly or impliedly" suggest the claimed invention as required by MPEP 706.02(j). This leaves for the Examiner the duty to "present a convincing line of reasoning as to why the artisan would have found the claimed invention obvious in light of the teachings of the references". The Examiner's line of reasoning is that "1) Deaton et al. maintains the information necessary to compute such a calculation and 2) computing such a calculation would provide the system with enhanced information...", as stated in the FOA at pages 3 and 5. In other words, the Office's argument is that the artisan could, in

some unspecified way, somehow compute the lifecycle factor because it would lead to better information. It is respectfully submitted that this line of reasoning is inadequate on its face.

Section 706.02(j) also states:

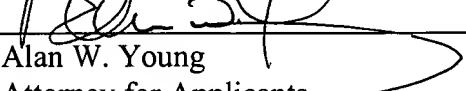
To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

It is respectfully submitted that the requisite motivation is absent from Deaton et al., that the Examiner has not carried his burden of proving the *prima facie* case through failure to present a convincing line of reasoning, and has not shown either how Deaton et al. could be modified to meet the claims on appeal or any motivation for doing so (i.e., why would the artisan do so?), other than the throwaway "enhanced information" argument.

For at least the reasons outlined above, it is believed that the Review Panel should allow this application or at least re-open the prosecution thereof, with new art and/or new grounds for rejection. The same is, therefore, respectfully requested.

Respectfully submitted,

Date: Jan 26, 2006

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